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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,301	04/04/2005	Franz Konrad	KONRAD 10 PCT	9924
25889 7590 10/01/2008 COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576				
EXAMINER KILPATRICK, BRYAN T				
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
10/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/530,301

**Applicant(s)**

KONRAD, FRANZ

**Examiner**

BRYAN T. KILPATRICK

**Art Unit**

1797

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 72-140 is/are pending in the application.
- 4a) Of the above claim(s) 1-71 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72, 73, 76, 81, 101, 104, 128, 130, 135 and 138 is/are rejected.
- 7) ☒ Claim(s) 74, 75, 77-80, 82-100, 102, 103, 105-127, 129, 131-134, 136, 137, 139 and 140 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/04/2005 and 04/30/2007
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Summary***

1. This is the initial Office action based on the application 10/530,301 PCT filed September 29, 2003; effective filing date April 04, 2005.
2. Claims 72-140 are pending and have been fully considered; claims 1-71 are cancelled.

### ***Priority***

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
5. Regarding claims 72-73, 104, 128, 130, 135, and 138, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).
6. Regarding claim 101, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949).

In the present instance, claim 76 recites the broad recitation the external diameter of the cover element corresponding to the inner diameter of the holding chamber, and the claim also recites that this diameter is only slightly smaller which is the narrower statement of the range/limitation.

In the present instance, claim 81 recites the broad recitation several locking elements, and the claim also recites preferably four which is the narrower statement of the range/limitation.

In the present instance, claim 135 recites the broad recitation several positioning elements, and the claim also recites preferably four which is the narrower statement of the range/limitation.

***Allowable Subject Matter***

8. Claim 72 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
9. Claims 73, 76, 81, 101, 104, 128, 130, 135, and 138 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
10. Claims 74-75, 77-80, 82-100, 102-103, 105-127, 129, 131-134, 136-137, and 139-140 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
11. The following is a statement of reasons for the indication of allowable subject matter: Applicant claims a holding device having a holding chamber with a container wall surrounded by a holding container for a holding vessel. The holding device further contains a needle holder for a needle arrangement, several adjusting devices, a cover element for the needle arrangement mountable on the needle holder, locking arrangements, guide arrangements, positioning and support elements, and retaining, stopping, and securing elements. The instant holding device has a locking arrangement

using the cover element, holding chamber, and needle arrangement in which the needle arrangement can be locked in place along a longitudinal axis.

No prior art of record has been found to show or suggest the specific locking arrangement in the disclosed holding device. BONALDO (U.S. Patent 4,774,964) discloses a blood collection device in the Abstract having two disc, one having a needle fixed to it and the other having a aperture axially formed for allowing one end of the needle to pass there through, that move along a longitudinal axis (laterally) and lock the needle in place along the axis. HALSETH et al. (U.S. Patent 6,524,276 and U.S. Patent Application Publication 2003/0105432) discloses in the Abstract a medical device for collecting fluid samples where after use guides the needle to a tilted position off-axis in the device. SAULENAS et al. (U.S. Patent 7,182,734) discloses in the Abstract a retractable safety needle assembly where the needle is contained entirely within the body of the assembly and are offset from a general axis defining the body. WILKINSON (U.S. Patent 7,258,678) discloses in the Abstract a retractable safety needle apparatus where the needle is contained entirely within the assembly upon using a deflectable actuator.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRYAN T. KILPATRICK whose telephone number is (571)270-5553. The examiner can normally be reached on Mon - Thurs, 7:00 am - 4:30 pm; Fri, 7:00 am - 11:00 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Jill Warden/  
Supervisory Patent Examiner, Art Unit 1797